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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/727,236 11/30/00 LINDERMAN

R 5051.509

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EXAMINER

LUKTON, D.

ART UNIT	PAPER NUMBER
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1653

DATE MAILED:

07/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.  
09/727,236

Applicant  
Linderman

Examiner  
David Lukton

Art Unit  
1653



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) ☒ Responsive to communication(s) filed on Mar 15, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4) ☒ Claim(s) 1-60 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-60 are subject to restriction and/or election requirements.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- 1. ☐ Certified copies of the priority documents have been received.
- 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

① This application contains sequence disclosures that are encompassed by the definitions for amino acid sequences set forth in 37 CFR 1.821. However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 with regard to the sequence disclosures.

See, for example, the sequences on page 4, paragraph 2.

Applicant is given the time period set in this letter within which to comply with the sequence rules, 37 CFR 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period.

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Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-14, drawn to a method of controlling a pest by administering a compound in which  $R_1$  is  $-NH_2$ .
2. Claims 1-14, drawn to a method of controlling a pest by administering a compound in which  $R_1$  is hydrogen or hydroxyl.
3. Claims 15-19, drawn to a method of initiating a TMOF receptor-mediated biological response using a compound in which  $R_1$  is  $-NH_2$ .
4. Claims 15-19, drawn to a method of initiating a TMOF receptor-mediated biological response using a compound in which  $R_1$  is hydrogen or hydroxyl.

5. Claims 20-30, drawn to a compound in which  $R_1$  is  $-NH_2$ .
6. Claims 20-30, drawn to a compound in which  $R_1$  is hydrogen or hydroxyl.
7. Claims 31-49, drawn to a method of controlling a pest or initiating a TMOF receptor-mediated biological response.
8. Claims 50-60, drawn to compounds.

The claimed inventions are distinct.

Each of claims 1, 15 and 20 has been bisected into two groups, depending on the presence of an amino group at  $R_1$ . It is asserted that some of the compounds are known in which  $R_1$  is amino. Applicants' proviso at the end of claim 1 is noted. However, it is not clear what exactly is excluded. First, the language used is "subject to". This could mean that the exclusion is merely an option, not a requirement. Second, the first proviso is that one of  $R_7$  and  $R_8$  is carboxy or alkylcarboxy; however, this is confusing because the claim otherwise prohibits  $R_7$  from being carboxy, and prohibits  $R_8$  from being alkylcarboxy. So to exclude something that is not claimed to begin with does not make sense. Third, the second proviso makes reference to a variable "R". However, there is no variable "R" present in the formula. Perhaps applicants intend to refer to  $R_7$ . This still leaves the possibility that  $R_1$  can be amino, at the same time that "A" represents a proline. It is likely that such compounds are known in the prior art.

Inventions {5, 6} and {1-4} are related as product and process of use. The inventions can

be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). Nevertheless, in the event that one of the groups drawn to compounds is elected, and claims therein found allowable, the corresponding method-of-use claims will be rejoined for further examination [*In re Ochiai* (37 USPQ2d 1127)]. Of course, in such a case, whatever limitations were agreed to for the genus of compounds would apply also to the methods.

Further rejoining is not precluded by the fact of initial restriction. For example, if applicants were to elect either of Groups 1 or 2, and that group proved to be novel, or mostly novel, the other (of the two) would likely be rejoined.

With respect to Groups 3 and 4, there is the matter of inherency. For example, suppose that process  $G \rightarrow H$  (below) is a TMOF receptor-mediated biological response:

$$A \rightarrow B \rightarrow C \rightarrow D \rightarrow E \rightarrow F \rightarrow G \rightarrow H \rightarrow I \rightarrow J \rightarrow K \rightarrow L \rightarrow M \rightarrow N$$

This would make the process of  $A \rightarrow N$  also a TMOF receptor-mediated biological response. It is unlikely that the potential inherency issues will be settled at this point. However, the fact that such issues will have to be addressed provides some justification for restricting between the method of claim 15, and the method of claim 1.

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Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific compound, with all substituent variables accounted for. In the event that applicants elect one of the groups of claims drawn to a method of controlling a pest, a second species election is that of a specific pest. In the event that applicants elect either of Groups 3 or 4, a second species election is that of a specific TMOF receptor-mediated biological response. Thus, in the event that Group 7 is elected, a total of three species elections is required.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.


Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
**DAVID LUKTON**  
**PATENT EXAMINER**  
**GROUP 1800**